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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,149	01/05/2001	Miwako Doi	05225.0193	3467

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EXAMINER

TIV, BACKHEAN

ART UNIT PAPER NUMBER

2151

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/754,149	DOI ET AL.	
	Examiner	Art Unit	
	Backhean Tiv	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/26/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/01, 4/02, 7/02, 6/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-24 are pending in this Office Action. Applicant's election without traverse of claims 5-16 on 5/26/04 is acknowledged.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure, statements filed 1/5/01,4/29/02,7/29/02,6/3/04, have been considered. However, DE 19638072 was not considered because there was no English translation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,6, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,629,136 issued to Naidoo in view of WO 01/28273 issued to Lammi.

As per claim 5, Naidoo teaches a service providing system, comprising:

a service provider configured to provide a service dependent on location information of a mobile terminal to the mobile terminal in response to a service request with the location information sent by the mobile terminal(Fig.4, col.2,lines 60-64);

Naidoo however, does not explicitly teach a communication control unit configured to control communication between the mobile terminal and said service provider, wherein said communication control unit converts a user identifier of the mobile terminal in the service request to a temporary identifier.

Lammi teaches a communication control unit configured to control communication between the mobile terminal and said service provider(page 7, lines 11-36; it is implicit that there is a communication control unit in the terminal device because the terminal device is communicating with the service provider, there must be a communication control unit in order for this to happen), wherein said communication control unit converts a user identifier of the mobile terminal in the service request to a temporary identifier(page 5, lines 3-15; the anonymous identifier is interpreted to be the temporary identifier).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo to explicitly add a communication control unit configured to control communication between the mobile terminal and said service provider, wherein said communication control unit converts a user identifier of the mobile terminal in the service request to a temporary identifier as taught by Lammi.

One skilled in the art would have been motivated to combine Naidoo and Lammi in order to protect the user identifier of a service user from the service provider in a mobile communication network(Lammi, page 4, lines 2-4).

As per claim 6, the service providing system according to claim 5, further comprising: a location information provider configured to provide the location information to the mobile terminal in response a location information request sent by the mobile terminal(Naidoo, col.4, lines 31-48). One skilled in the art would have been motivated to combine Naidoo and Lammi for the same reason set forth in claim 5.

As per claim 14, Naidoo teaches a service providing system, comprising:
a user non-identification service provider configured to provide a service not requiring a user identification to the mobile terminal(col.3, lines 59-col. 4, lines 10).

Naidoo however does not explicitly teach a user identification service provider configured to provide a service requiring a user identification to a mobile terminal of the user;

communication control unit configured to control communication among the mobile terminal said user identification service provider, and said user non-identification service provider,

wherein said communication control unit converts a user identifier of the mobile terminal in a service request information sent by the mobile terminal to a temporary identifier.

Lammi teaches a user identification service provider configured provide a service requiring a user identification to a mobile terminal of the user(page 4, lines 23-34);

a communication control unit configured to control communication among the mobile terminal said user identification service provider, and said user non-identification service provider(page 7, lines 11-36; it is implicit that there is a communication control unit in the terminal device because the terminal device is communicating with the service provider, there must be a communication control unit in order for this to happen),

wherein said communication control unit converts a user identifier of the mobile terminal in a service request information sent by the mobile terminal to a temporary identifier(page 5, lines 3-15).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo to explicitly add a user identification service provider configured to provide a service requiring a user identification to a mobile terminal of the user; a communication control unit configured to control communication among the mobile terminal said user identification service provider, and said user non-identification service provider, wherein said communication control unit converts a user identifier of the mobile terminal in a service request information sent by the mobile terminal to a temporary identifier as taught by Lammi.

One skilled in the art would have been motivated to combine Naidoo and Lammi in order to protect the user identifier of a service user from the service provider in a mobile communication network(Lammi, page 4, lines 2-4).

As per claim 15, the service providing system according to claim 14, communication control unit sends a user identification service request including the temporary identifier to said user identification service provider in response to a user identification service request sent by the mobile terminal(Lammi, page 5, lines 3-15). One skilled in the art would have been motivated to combine Naidoo and Lammi for the same reason set forth in claim 14.

As per claim 16, the service providing system according to claim 15, wherein said communication control unit sends a user non-identification service request without the temporary identifier to said user non-identification service provider in response to a user non- identification service request sent by the mobile terminal(col.3, lines 59-col. 4, lines 10). One skilled in the art would have been motivated to combine Naidoo and Lammi for the same reason set forth in claim 14.

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,629,136 issued to Naidoo in view of WO 01/28273 issued to Lammi in further view of US Patent 6,330,598 issued to Beckwith et al.(Beckwith).

Naidoo in view of Lammi teaches all the limitations of claim 5, and further teaches as per claim 7, the service providing system according to claim 5, wherein said communication control unit stores communication control information consisting of a service request identifier(Lammi, page 4, lines 23-25), the location information(Naidoo, col.4, lines 46-48), the temporary identifier(Lammi, page 5, lines 3-7)and a parameter in response to the service request(Naidoo, col.8, lines 26-40) and the location information sent by the mobile terminal(Naidoo, col.4, lines 46-48).

Naidoo in view of Lammi however does not teach a service provider name.

Beckwith teaches a service provider name(col.10,lines 28-30).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo in view of Lammi to explicitly add a service provider name as taught by Beckwith.

One skilled in the art would have been motivated to combine Naidoo and Lammi and Beckwith in order to manage a subscription package of service(Beckwith, col.10, lines 44-46).

As per claim 8, the service providing system according to claim 7, wherein said communication control unit sends service request information consisting of the service request identifier, the service provider name, the location identifier, and the parameter to said service provider(Naidoo, col.4, lines 31-47; Naidoo teaches sending information from the communication device to the content provider). One skilled in the art would have been motivated to combine Naidoo

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and Lammi and Beckwith in order send information between the communication device and the service provider.

As per claim 9, the service providing system according to claim 8, wherein said service provider stores service request information consisting of the service request identifier(Naidoo, col.8, lines 25-41), a wireless gateway identifier of said communication control unit(Lammi, page 7, lines 24-26), the location information and the parameter in response to the service request information sent by said communication control unit(Naidoo, col.8, lines 25-41). One skilled in the art would have been motivated to combine Naidoo and Lammi and Beckwith in order store information of the requested information.

As per claim 10, the service providing system according to claim 9, wherein said service provider creates service information by referring to the parameter, and sends service response information consisting of the service request identifier, the location information and the service information to said communication control unit(Naidoo,col.4, lines 31-48). One skilled in the art would have been motivated to combine Naidoo and Lammi and Beckwith for the same reason set forth in claim 8.

As per claim 11, the service providing system according to claim 10, wherein said communication control unit reconverts the temporary identifier corresponding to the service response identifier in the service response information to the user identifier in response to the service response information sent by said service provider, and sends the service information to the mobile terminal of the user identifier(Lammi, page 9, lines 5-12). One skilled in the art

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would have been motivated to combine Naidoo and Lammi and Beckwith for the same reason set forth in claim 8.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,629,136 issued to Naidoo in view of WO 01/28273 issued to Lammi in further view of US Patent 6,636,489 issued to Fingerhut.

Naidoo in view of Lammi teaches all the limitations of claim 5, however does not teach as per claim 12, the service providing system according to claim 5, further comprising: a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit.

Fingerhut teaches a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit(col.1, lines 41-64).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo in view of Lammi to explicitly add a a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit as taught by Fingerhut.

One skilled in the art would have been motivated to combine Naidoo and Lammi and Fingerhut in order provide a wireless subscription management system(Fingerhut, col.1, lines 39-41).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,629,136 issued to Naidoo in view of WO 01/28273 issued to Lammi in further view of US Patent 6,636,489 issued to Fingerhut in further view of US Patent 6,330,598 issued to Beckwith et al.(Beckwith).

Naidoo in view of Lammi in further view of Fingerhut teaches all the limitations of claim 12, and further teaches as per claim 13, the service providing system according to claim 12, wherein said communication control unit stores communication control information consisting of the service request identifier(Lammi, page 4, lines 23-25), the temporary identifier(Lammi, page 5, lines 3-7) and the parameter in response to the service request information irrelevant of the location sent by the mobile terminal(Naidoo, col.8, lines 26-40), and sends the service request information which is the same as the communication control information to said location independent service provider(Fingerhut, col.1, lines 41-52).

Naidoo in view of Lammi in further view of Fingerhut does not teach, however, the service provider name.

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo in view of Lammi in

further view of Fingerhut to explicitly add a service provider name as taught by Beckwith.

One skilled in the art would have been motivated to combine Naidoo and Lammi and Fingerhut and Beckwith in order to manage a subscription package of service(Beckwith, col.10, lines 44-46).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,571,279 issued to Herz et al. "Location Enhanced Information Delivery System"

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (703) 305-8879. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (703) 308-6687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BT

Backhean Tiv
2151
7/21/04


ZARNI MAUNG
PRIMARY EXAMINER